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**AMENDMENTS TO THE DRAWINGS**

The attached drawing sheet includes a change to Figure 1 to add a label "3" for the dashboard of the automobile upon which the present invention is mounted. This sheet replaces the original sheet which contains Figure 1.

Attachments: Replacement Sheet for Figures 1 and 2.  
Annotated Sheet Showing Change to Figure 1.

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### **REMARKS**

Entry of this Amendment is proper under 37 CFR §1.116, since no new claims or issues are raised.

It is noted that, notwithstanding any claim amendments made herein, Applicant's intent is to encompass equivalents of all claim elements, even if amended herein or later during prosecution.

Claims 3-5, 11-14, 16-21, and 31-37 are all of the claims pending in the present Application.

According to the latest Office Action dated November 30, 2004, claims 5, 18, and 21 are allowed. Applicants gratefully acknowledge the Examiner's indication that claims 13, 14, and 33-35 would be allowable if rewritten in independent format. However, Applicants decline to rewrite these claims in independent format at this time, since it is believed that the present invention, as defined by the independent claims is clearly patentable over the prior art of record, when properly understood and when a reasonable evaluation is conducted, as explained below.

In the latest Office Action, claims 3, 4, 11, 12, 36, and 37 stand rejected under 35 USC §103(a) as unpatentable over Japanese Patent JP 07-160203 to Satoru et al., further in view of US Patent 5,075,686 to Shigemura, and further in view of US Patent 5,905,914 to Sakai et al. Claims 16 and 17 stand rejected under 35 USC §103(a) as unpatentable over Satoru/Shigemura/Sakai, further in view of US Patent 6,339,696 to Chan et al. Claims 19, 20, 31, and 32 stand rejected under 35 USC §103(a) as unpatentable over Satoru/Shigemura/Sakai, further in view of US Patent 6,144,358 to Narayanaswamy et al.

These rejections are respectfully traversed in view of the following discussion, since the piecemeal evaluation currently of record is clearly the result of improper hindsight.

### **I. THE CLAIMED INVENTION**

As disclosed and described by, for example, claim 3, the present invention is directed to a vehicle-mounted apparatus, including a first panel including a first display. The first panel is mountable substantially directly onto a surface of a vehicle. A second panel includes a second display, the second panel being openable and closeable with respect to the first display

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about a side thereof as an axis. There is an operating switch. A means is provided for changing a function indication on the operating switch according to whether the second panel is open or closed.

Advantages of the present invention over prior art configurations include that it provides a display/control apparatus that minimizes space and reduces complexity for the control switching.

Moreover, relative to the device taught in Satoru, the present invention provides a simple mounting technique (i.e., substantially directly to the surface) that does not need an expensive and complex motor-driven linkages and mechanism. Additionally, the present invention provides a control panel on the back face of the second panel, thereby allowing more space on each panel to be devoted to the display function and provides a display configuration in which a portion of the first display can be left uncovered when the second panel is in the closed position, thereby allowing the exposed portion of the first panel to serve as a small display area even when the panels are fully closed, relative to each other.

## II. THE PRIOR ART REJECTIONS

The Examiner alleges that claims 3, 4, 11, 12, 36, and 37 are rendered obvious by JP 07-160203 to Satoru et al., further in view of Shigemura, and further in view of Sakai et al.

Applicants again submit that the first panel 41 in Satoru cannot be mounted onto the surface of an automobile (e.g., a dashboard). In his response in Paragraph 6 on page 11 of the Office Action dated November 30, 2004, the Examiner points to Drawing 4 of Satoru.

However, it is submitted that Drawing 4 of Satoru merely shows the entire apparatus 11, including display panels 41,51, in the environment of an automobile control stand/dashboard. Applicants again submit that, as clearly shown in Drawing 1, neither panel 41,51 are mounted on a surface of the automobile. Indeed, should first panel 41 be mounted onto a surface of the automobile, the entire purpose and mechanical mechanism of the apparatus 11 would be defeated.

However, in an attempt to expedite prosecution, Applicants have amended the claims to clarify that the first panel is mounted substantially directly onto the surface of the

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automobile.

Applicants again submit that the first panel 41 and second panel 51 in Satoru do not fully close relative to each other. In his response, the Examiner points to item 86 of Drawing 10 as the hinge around which the first panel 41 and second panel 51 are attached. However, Applicants again submit that, as clearly shown in studying Drawing 1 and Drawing 2, the lower module 13, which includes first panel 41, is retracted by linkage 25,28 into the chassis of apparatus 11. The upper module 14, which includes second panel 51, is controlled during this retraction by the hinge mechanism 32,36 to be lowered into its lower position whenever the first panel 41 is retracted.

Thus, it is clear that the first panel 41 and second panel 51 are never fully closed. Rather, at most, they are either fully open or perpendicular to each other.

In his response, at the bottom of page 11 and continuing on to the top of page 12, the Examiner states:

*"On page 12, 5<sup>th</sup> paragraph Applicant stated, that Satoru et al. could not be modified because such modification would clearly defeat the principle operation. However, Examiner disagreed. Adding new mechanical features will not change the principle of operation of reference."*

In response, Applicants submit that, should the first panel 41 of Satoru be mounted directly onto a surface (e.g., the dashboard), there would no longer be the retraction mechanism to pull the lower module 13 into the chassis 11. Moreover, the linkage 31,35 shown in Drawing 1 that interconnects the lower module 13 with the upper module 14 would no longer function, since the lower module 13 would be permanently mounted to a surface. Moreover, depending upon which surface the lower module 13 were to be mounted, it might not even be possible to rotate the upper module 14 around the hinge mechanism, since the surface upon which the lower module 13 is mounted would stand in the way of any relative motion around this hinge mechanism.

Therefore, contrary to the Examiner's statement, Applicants submit that the entire motion mechanism in Satoru would clearly be defeated by mounting the first panel 41 directly to a surface, rather than using the retraction mechanism clearly shown in Drawing 1.

In his response in the first full paragraph on page 12, the Examiner refers to the lines

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from *In re McLaughlin* often recited by Examiners: "Any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper."

What the Examiner fails to understand is that this line is taken outside the context of the facts and surrounding statements in that case. More specifically, the holding in this case continues on, as follows:

*"The Cook patent does indicate that the car shown therein is suitable for carrying palletized loads with lift trucks being used for the loading and unloading, including stacking of the pallets. Since the secondary references show that it was well known to use side filler panels and bulkheads to confine palletized loads to prevent lateral and longitudinal shifting, we agree that those references would have suggested use of such panels and bulkheads with the Cook car for the same purpose."*

In other words, given that the primary reference Cook and the secondary references were all directly related to the problem of loading boxcars and the missing element was shown by the secondary references to provide the same purpose used in the McLaughlin patent application, the Court reasonably agreed with the Board of Appeals that, in this case, the secondary references reasonably suggested the missing element.

Applicants first submit that this recitation is not an appropriate response to the Applicants' point in the second paragraph on page 13 of the previous Amendment (filed on July 22, 2004) that the Examiner is merely using the claimed invention as a roadmap to redesign the prior art references until the claimed invention is reached. As pointed out above, the Satoru first panel 41 cannot be mounted directly to a surface in the automobile without totally defeating the mechanical operation of that reference. It is clear that the Examiner is simply redesigning Satoru.

Second, Applicants submit that, unlike the facts in *McLaughlin*, the purposes and environments of the secondary references in the present evaluation are clearly different from the primary reference Satoru. That is, as clearly stated in the Abstract of Satoru, the primary reference is intended to expand the area of the display screen of the navigation system used in

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an automotive environment. Satoru achieves this goal by having the lower panel 41 stowed inside casing 11 to assume "... *a rising posture in front of a casing 11 and the second display member 14 is installed thereon flush with each other. The screens 41 and 51 of both display members 13 and 14 exist adjacently to widen the substantial display area.*"

In contrast, Shigemura addresses the prior art problem in, for example, a facsimile apparatus, in which an opening/closing cover changes the function of switches. The solution in Shigemura is to incorporate a sliding cover that changes the functions. As Applicants have already pointed out, Satoru does not have the opening/closing cover that presents the problem to be solved in Shigemura. Therefore, in accordance with the above-recited wording from *In re McLaughlin*, since the environment and purpose are not present in the primary reference Satoru, it would not be proper to use this secondary reference.

Similarly, the secondary reference Sakai addresses a prior art problem with portable computers. As best understood, the Examiner uses an opening/closing switch 156 in Figure 57 in Sakai to further modify the sliding switch of Shigemura that overcomes the opening/closing cover problem discussed therein to presumably place the sliding switch of Shigemura back into the condition that it was intended to solve. This circle of design and re-design is clearly hindsight.

Finally, in his response in the final paragraph of Paragraph 6 on page 12, the Examiner alleges that motivation in the prior art rejection is justified by the description at lines 63-66 of column 1 of Shigemura and in lines 51-54 of column 5 of Sakai.

However, Applicants again submit that these lines in Shigemura and Sakai merely recite the benefit achieved by that reference relative to the problems being addressed in those references. In other words, the Examiner merely recites the benefit that would be achieved if that change were to be incorporated in the environment of that prior art reference.

This approach is entirely different than asserting that the secondary reference suggests using the missing element in any and all possible environments and different problems. Satoru does not have the problems addressed in these secondary references and is clearly not in the same environments.

The approach of the rejection currently of record is that elements missing in a primary prior art reference need merely be located in a secondary prior art reference and the

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motivation to modify the primary reference would be a statement in the Summary section that describes the advantages achieved by that secondary reference relative to its described problem.

As very clearly described in *In re McLaughlin*, this approach works only if the environments and purposes are the same between the primary reference and the secondary references. The circular reasoning demonstrated in the rejection currently of record, in which the motivation to modify the primary reference is merely that of obtaining the benefit of having made the modification, would render everything obvious, since inventions are almost always merely a new combination of known elements.

As *In re McLaughlin* confirms, a proper evaluation must consider whether the environments are the same and whether the purpose of the elements and problems being addressed are the same. Without this objectivity, the prior art evaluation is merely the location of the missing prior art elements in secondary references and patentability would depend upon being the first to identify an element that cannot be located. Moreover, that first identification would then preclude that new element from being patentably significant in any other further invention.

For these reasons, Applicants again submit that merely locating the missing elements in secondary references is in itself unimportant unless the environment and purpose of the secondary references are reasonably close to the environment and problem being addressed in the primary reference. Without such objectivity, the prior art rejection merely becomes an academic exercise in using claims as a roadmap to re-design the primary reference until it finally matches the claimed invention.

However, as noted above, in conclusion, even if all secondary reference were to be combined with the primary reference Satoru, the result would still not provide the description of the plain meaning of the language in the independent claims.

That is, the "first panel", as defined by claim 3, is required to be "said first panel being substantially directly mountable onto a surface of a vehicle." The panel 13 of is clearly mounted in casing 11 and, therefore, not at all mountable onto a surface of a vehicle. It is irrelevant that the casing 11 is or is not mounted on a surface, since that condition is not being described by the claims.

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The Examiner relies on Shigemura to teach switching that changes function, upon Sakai for an operating switch, upon Chan to teach an audio/video source, and upon Narayanaswamy to teach detecting a position. None of these references overcome the basic deficiency identified above for Satoru.

Hence, turning to the clear language of the claims, in Satoru there is no teaching or suggestion of: "... said first panel being substantially directly mountable onto a surface of a vehicle....", as required by the independent claims. Therefore, all claims are clearly patentable over Satoru, if for no reason other than dependency.

### III. FORMAL MATTERS AND CONCLUSION

The Examiner objected to the drawings for failing to show the feature that the present invention is intended to be mounted on a surface of an automobile. Applicants believe that the above drawing and specification changes address this concern and respectfully request that the Examiner reconsider and withdraw this objection.

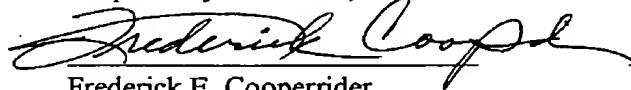
In view of the foregoing, Applicants submit that claims 3-5, 11-14, 16-21, and 31-37, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Date: 2/22/05

Respectfully Submitted,



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